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Ex parte Woodbridge. Dec. Comm of Patents, 1879-p 30... 13.

In the Supreme Court of the United States.

SAMUEL HOMER WOODBRIDGE AND EDWARD WOODBRIDGE BARNES, executors of WILLIAM E. WOODBRIDGE, deceased, appellants,

v.

THE UNITED STATES.

No. 51.

APPEAL FROM THE COURT OF CLAIMS.

BRIEF ON BEHALF OF APPELLEE.

Appellant's brief is so largely made up of references to evidence and allegations of fact that are not in the Findings of Fact which have gone up from the Court below, and, in some cases, as appears from the brief itself, not even before the lower court, and the arguments offered are thus so based on a commingling of found and unfound facts that appellee finds it difficult to reply without a laborious and lengthy separation of matters of alleged fact which are, from those which are not, before this Court. To point out these numerous departures from the Findings of Fact would unduly expand this brief. Happily, it is not necessary, for the facts found by the Court are few and simple, and fully adequate to

dispose of the legal questions involved, which only are here for review.

The "Statement of the Case" by appellant's brief is excepted to for its inclusion of facts that are not "found" by the Court below, and its statement of mere conclusions of counsel from those facts. A brief outline of the case is as follows:

STATEMENT OF THE CASE.

This is an appeal from a decision of the Court of Claims dismissing a petition filed by the executors of William E. Woodbridge for compensation for the use by the United States of an invention, application for which was filed the 11th day of February, 1852, but upon which application letters-patent never issued.

The case comes before this Court for ruling on the question of abandonment after five successive tribunals have unanimously decided that issue against appellant. He has been held to have abandoned his invention by the Examiner in the Patent Office, on appeal by the Board of Examiners in Chief, on second appeal by the Commissioner of Patents, on third appeal by the Supreme Court of the District of Columbia, and now on full trial of the issue under a special jurisdictional Act, by the Court of Claims.

THE JURISDICTIONAL ACT.

The jurisdiction of the Court of Claims, and necessarily this Court on appeal, was invoked by reason of a joint resolution of the Senate and the

House of Representatives of the United States, which is on pages 1 and 2 of the Record.

It is, of course, apparent that the proviso, "*Provided, however*, That the said Court shall *first* be satisfied that the said Woodbridge did not forfeit or abandon his right to a patent, by publication, delay, laches, or otherwise, and that the said patent was wrongfully refused to be issued by the Patent Office," makes it the duty of the Court of Claims to decide the questions enumerated, or as the Court in its opinion (Tr. p. 26) states:

> The provision is, in effect, a condition precedent to the plaintiff's right of recovery.

And further, on the same page, the Court states:

> When, however, Congress in a mandatory provision of the jurisdictional act enjoins a positive condition precedent, a preliminary requirement which must be met before further substantive proceedings may go on, it is a legislative burden cast upon the plaintiffs to meet.

Plaintiffs then must establish to the satisfaction of the Court of Claims that Woodbridge did not forfeit or abandon his right to a patent by publication, delay, laches, or otherwise; and that the said patent was wrongfully refused to be issued by the Patent Office. Failure to meet these requirements must result in a decision against the plaintiffs' claim.

The Court of Claims, in making its findings of fact, nowhere found, in terms, either that Woodbridge

forfeited or abandoned his right to a patent by publication, delay, laches, or otherwise, or that the patent was rightfully refused by the Patent Office, or as the statutory reference states it in the negative, the Court did not positively make a finding of fact answering the Congressional reference—

> That the said Court shall first be satisfied that the said Woodbridge did not forfeit, or abandon his right to a patent, by publication, delay, laches, or otherwise; and that the said patent was wrongfully refused to be issued by the Patent Office. (Tr. p. 1, 2.)

The Court, however, found (Finding XIV, p. 23) that the United States never used the invention which was the subject of the Woodbridge application:

> *Finding XIV.*—It does not appear that any of the improvements or devices for which letters patent were so ordered to issue to the said William E. Woodbridge were manufactured or used by the United States as alleged by the plaintiffs' petition, in this suit.

Further, the Court of Claims, as the conclusion of law gathered from the circumstances and facts found, held (Tr. p. 23):

> Upon the foregoing findings of fact the Court decides, as a conclusion of law, that the plaintiffs' petition should be, and it is hereby, dismissed. Judgment is rendered in favor of the United States, against the plaintiff, for the cost of printing the record herein,

the amount thereof to be entered by the Chief Clerk and collected by him according to law.

From the failure of the Court to make a positive finding of fact as to abandonment, laches, etc., there arises the almost necessary implication that the Court was not satisfied that Woodbridge had not forfeited or abandoned his right to a patent, and that the Patent Office had not wrongfully refused to issue the patent. Furthermore, the congressional reference having specifically directed an initial inquiry to be made—i. e., the Court to be first satisfied that Woodbridge had not lost his rights—failure of the Court to so find, or its silence upon this fact in its findings, results in a failure of jurisdiction as not being in compliance with the congressional reference upon which its jurisdiction was, of course, dependent. The attention of this Court is directed to the question of whether or not in such a situation appellant has any standing before this Court jurisdictionally. And, further, as to the expediency of this Court remanding the case for a definite finding of fact as to abandonment. Abandonment is a question of fact. (*Kendall* v. *Winsor*, 21 How. 322.)

The attorneys for the United States at the present time did not participate in the trial in the Court of Claims, and feel reluctant to urge a remand for an additional finding in view of over seventy years of delay between the filing of the application in the Patent Office and this hearing.

The ultimate action of the Court of Claims in dismissing the petition inferentially is a denial by that Court of its satisfaction that Woodbridge has not forfeited his right to receive a patent, and also the conclusion is irresistible that the Court of Claims so considered the question, for in its unanimous opinion (Tr. p. 35, lines 13, 14, 15) the following language is used:

> We can not escape the conclusion in view of these facts that Woodbridge abandoned his right to letters patent.

Surely it can not be contended that there remains a scintilla of doubt as to what attitude the Court of Claims assumed with respect to the question of abandonment.

HISTORY OF THE WOODBRIDGE INVENTION.

On February 11, 1852, William E. Woodbridge filed in the United States Patent Office an application for an improvement for rifled ordnance. (Finding of Fact I, Tr. 9.) February 16, 1852, the Patent Office rejected his application and claims as "containing nothing new or patentable." (Finding of Fact I, Tr. 11.)

On February 23, 1852 (same page), Woodbridge replied to the rejection of the Patent Office and sought to distinguish his invention from the inventions cited by the Patent Office. Thereafter, on March 19, 1852 (Tr. 12), the Patent Office, after considering the argument set forth by Woodbridge, suggested two claims, which, in the opinion of the Patent Office, were al-

lowable. Woodbridge thereupon, on March 23, 1852, adopted the claims suggested by the Patent Office and amended his application by a letter reading as follows:

> I return herewith my specification, amended, as I suppose, according to your desire, and also the necessary duplicate drawings. I was informed, in answer to my inquiry, that upon the issue, or order to issue, of a patent, it may be filed in the secret archives of your Office (at the risk of the patentee) for such time as he may desire. I wish to avail myself of this privilege when my patent may issue, in order that my ability to take out a patent in a foreign country may not be affected by the publication of the invention. If it is necessary to specify a particular time during which the patent shall remain in the secret archives, you will please consider one year as the time designated by me. (Finding of Fact I, Rec. p. 13.)

In reply to this communication the Patent Office on April 15, 1852, wrote Woodbridge:

> Your favor of the 13th instant is received. Your application for letters patent for rifled ordnance has been examined, and on the 25th ult. a patent was ordered to issue thereon, and in accordance with your request, the papers were filed among the secret archives of the Office, subject to your direction as to the time of issuing the same. Finding of Fact I (Tr. 13).

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PATENT ACT OF 1836 DEFINED THE RIGHTS OF WOODBRIDGE AT THE TIME OF FILING HIS APPLICATION.

For an understanding of Woodbridge's request that his allowed application be filed in the secret archives of the Patent Office an examination of the patent law at that time is illuminating. The Patent Act of 1836 was the measure of Woodbridge's rights at that date, and the only section of that act in any way suggestive of or permissive of such a practice was Section 8, 5 Stats. 121, which provides:

> * * * But nothing in this act contained shall be construed to deprive an original and true inventor of the right to a patent for his invention, by reason of his having previously taken out letters patent therefor in a foreign country, and the same having been published, at any time within six months next preceding the filing of his specification and drawings. And whenever the applicant shall request it, the patent shall take date from the time of the filing of the specification and drawings, not however exceeding six months prior to the actual issuing of the patent; and on like request, and the payment of the duty herein required, by any applicant, his specification and drawings shall be filed in the secret archives of the Office until he shall furnish the model and the patent to be issued, not exceeding the term of one year, the applicant being entitled to notice of interfering applications.

The last phrase of the statute quoted, reading:

> and on like request and the payment of the duty herein required, by any applicant, his

> specification and drawings shall be filed in the secret archives of the office until he shall furnish the model and the patent to be issued, not exceeding the term of one year, the applicant being entitled to notice of interfering applications

is the only ~~jurisdiction~~ language contained in the Patent Act of 1836 which suggests or allows a filing of an application in the "secret archives," and it is to be noted that such secret filing is only for the purpose of completing the application by the furnishing of a model. It never contemplated any other reason than the one stated—i. e., the secrecy period extending to the doing of an act which completed an otherwise incomplete application and could not be expanded to cover cases other than those mentioned in the act.

The statute applied to pending applications in which nothing remained to be done but the furnishing of a model and the issuance of the patent. The purpose—and the only purpose—of this section was to give to such an application the protection of secrecy for one year, until the applicant furnished a model, which at that time was a statutory prerequisite to the issuance of a patent.

It is not found as a fact by the Court of Claims, but the appellants' petition (par. 3, Tr. p. 2) alleges, "a model was filed representing the invention" on the 11th day of February, 1852; so that there appears out of appellant's own mouth an admission that the only possible basis for the "secret filing"—i. e., the

incompleteness of the application for patent because of no model being filed—did not exist!

Appellants in their brief (bottom p. 18), speaking of the authority of the Commissioner of Patents to sanction or legalize the filing of Woodbridge's application in the secret archives, state:

> Fourth, it was done under authority of law, because of the implied authority of the Commissioner to establish a practice not inconsistent with the statutes and under the general authority of Section 1 of the Patent Act of 1836.

The very terms of Section 1 of the Act of 1836 define the Commissioner of Patents' duties or powers and limit them to "such acts and things touching and respecting the granting and issuing of patents for new and useful discoveries, inventions, and improvements, as are herein provided for, or shall hereafter be, by law, directed to be done and performed, and shall have the charge and custody of all the books, records, papers, models, machines, and all other things belonging to said office." (5 Stat. L. p. 117.)

The only expression concerning the power of the Commissioner is that all of his acts must be in conformity with the law, and it need not be added those acts for which there appears no warrant of law are a nullity.

Again on page 19 of appellants' brief it is contended that though there was no written rule of practice authorizing the Commissioner's act, yet there was

an "unwritten rule," as evidenced by Woodbridge's statement in his letter of 1852, that he had so been informed. It is submitted that it is the statutes concerning patents that are being considered and that rights asserted to flow from unwritten rules of the Patent Office or peculiar practices can have no weight whenever such procedure violates the plain spirit and letter of the statute.

It is deemed quite significant that if, as counsel for appellants suggests, the practice or unwritten rule existed that that is the *only* case, so far as counsel is aware, where any such rule has been suggested.

To summarize this branch of the case, it is submitted that, first, there is no provision of the Act of 1836 that gives warrant for the filing of completed applications in the secret archives of the Patent Office; second, appellants admit in their petition that the Woodbridge application was complete, containing specifications, drawings, and model; and, third, that neither Woodbridge by requesting, nor the then Commissioner of Patents by acquiescing, can lawfully depart from the plain direction of the statute.

WOODBRIDGE'S LONG DELAY.

Nine years eight months and sixteen days after Woodbridge had requested his allowed application be kept secret and had designated one year thereafter as the period of secrecy, and after the Patent Office had so filed his application (Tr. p. 13, Finding I), he, on December 31, 1861, addressed the Commissioner of Patents in a letter suggesting amendments to the

application and requesting the issue of said application if the Patent Office refused his offer of amendment. This letter, fully set forth under Finding of Fact III (Tr. p. 14), forever damns Woodbridge as being guilty of laches in the prosecution of his patent and stands as a bar to any relief in this Court, for, in explanation of the unconscionable period that his application had lain in secrecy in the Patent Office, he states in his letter:

> I have allowed it to remain until the present time, it being only lately that any immediate opportunity of rendering it pecuniarily available has ~~accrued~~ occurred. (Finding III, Tr. 14.)

Thereafter (Finding III, Tr. p. 15) correspondence was exchanged between Woodbridge and the Patent Office, the result of which was that the office finally refused to issue the application as a patent on account of the long delay, resulting in abandonment, and it was suggested that if applicant saw fit an appeal lay to the Board of Examiners in Chief from such decision.

Woodbridge took an appeal to the Board of Examiners in Chief from the decision of the Examiner on April 15, 1862, which tribunal affirmed the ruling of the Examiner as to the abandonment of the application and invention July 10, 1862. (Finding V, Tr. p. 16.)

On January 7, 1871, Woodbridge appealed from the decision of the Board to the Commissioner of Patents, and because of a variety of circumstances this appeal was not heard until February 13, 1879, when the

Board's decision was affirmed upon the ground of abandonment. (Finding V, Tr. p. 16.) (Reported Dec. Commr. Patents, 1879, p. 32.)

Following this decision, Woodbridge on April 9, 1879, appealed from the Commissioner's decision to the Supreme Court of the District of Columbia, which Court on February 28, 1880, affirmed the Commissioner's decision. Twenty-one years after the decision in the Supreme Court in the District of Columbia, to wit, March 2, 1901, Congress referred the case to the Court of Claims, and after the petition was filed, March 7, 1901, appellants closed their case in 1913.

Four years later the appellants filed briefs, and in April, 1918, the case was argued before the Court of Claims—over sixty years after Woodbridge filed his application for patent.

THE WOODBRIDGE INVENTION ABANDONED AS THE RESULT OF LACHES AND DELAY FROM MARCH 25, 1852, TO DECEMBER 31, 1861.

Abandonment has repeatedly been held not to be presumed by mere lapse of time, but must be predicated of either an express declaration by the inventor or from circumstances from which abandonment must necessarily be found. (*Kendall* v. *Winsor*, 62 U. S. 322.) It is within the second phase of abandonment that the application and invention of Woodbridge falls.

Woodbridge had, previous to filing his application in 1852, tested his projectile and was apparently satisfied as to its efficiency. (Tr. p. 17, Finding of

Fact VII.) He had been successful in having the United States test, and its officers had reported to the Ordnance Bureau all information that such tests disclosed (Tr. pp. 17, 18, 19, Finding of Fact VII), so that when he filed his application on February 11, 1852, his invention was complete. When he made the request that the allowed claims in his application be secretly filed in the Patent Office, he gave as a reason that he wished to avail himself of the right to obtain foreign patents. (Tr. p. 13, Finding of Fact I.) Yet Woodbridge never made any attempt to procure foreign patents on his invention. (Tr. p. 21, Finding of Fact VIII.)

Unquestionably his real motive is disclosed in his belated letter to the Commissioner of Patents requesting the issue of the patent over nine years later. (Tr. p. 14, Finding of Fact III.)

> I have allowed it to remain until the present time, it being only lately that any immediate opportunity of rendering it pecuniarily available has occurred.

The Court of Claims (Tr. p. 16), in Finding of Fact IV, amplified this statement of Woodbridge and allows no uncertainty to exist as to his reason for attempting to extend his control over the invention. It was palpably to withhold from the public the advantages of his invention and extend the time within which ordinarily his patent would have expired, by keeping the invention secret in the Patent Office and not issuing it until the profitable use of the invention was assured and a golden harvest be reaped.

In *Macbeth-Evans Glass Co* v. *General Electric Co.*, 246 Fed. Rep. p. 700, the Circuit Court of Appeals for the Sixth Circuit, speaking of the purposes of the Patent Law with respect to the limitation by Congress of its terms, said:

> When a patent expires, the right to practice the invention thus becomes available to everybody. The object of such a limitation and disclosure was to secure to the public the full benefits of patented objects as speedily as was consistent with reasonable stimulation of invention. If then we assume that the course adopted by the present inventor and his assignee did not contemplate an intent to abandon the right to secure a patent, it certainly did contemplate an indefinite delay in disclosure of the invention and a practical and substantial enlargement of any period of monopoly recognized by statute. Can it be doubted that this was opposed to a declared and subsisting public policy?

Such a course of conduct is entirely at variance with the spirit of our patent law, which, as a consideration for the grant of the monopoly, requires a full acceptance by the inventor of the statutory conditions, and, furthermore, the fundamental principle of the grant is that the public gain a right to practice the invention or discovery at the end of a fixed term. This Court, in *Kendall* v. *Winsor*, 21 How. 322, 327, has aptly stated:

> It is undeniably true, that the limited and temporary monopoly granted to inventors

> was never designed for their exclusive profit or advantage; the benefit to the public or community at large was another and doubtless the primary object in granting and securing that monopoly.

The constitutional provision giving rise to all statute law controlling the rights of inventors and the granting of patents expresses the limitation by Congress on the exclusive rights of authors and inventors to their respective property. Article I, Sec. 8:

> The Congress shall have power * * * to promote the progress of science and the useful arts by securing for limited terms to authors and inventors the exclusive right to their respective writings and discoveries.

Under this authority Congress, by the Statute of 1836, denominated fourteen years as the time limitation found in the Constitution over which an inventor had security in his invention or the monopoly. Woodbridge, however, not satisfied with fourteen years of exclusive property, dating from the completion of his invention, sought, by secret filing of his application after allowance of his claims, to extend the period of control over his invention until such time as he—not Congress—might determine. His allowed application containing his invention lay secret in the Patent Office over nine years, a menace to all who in the meantime developed similar devices, and the Court of Claims has found (Tr. p. 22, Finding X), that during this period alone fourteen American patents for improvements in projectiles were issued.

A number of patents covering the types of projectiles for the use of which Woodbridge seeks to receive compensation from the United States were issued during the period between 1852 and 1861. (Tr. p. 40, Exhibit No. 8, Hotchkiss; Exhibits Nos. 9 and 10, Parrott, Tr. pp. 41 and 42; Exhibit 11, Sawyer, Tr. p. 43; and Exhibit 12, Dahlgren, Tr. p. 44.)

Woodbridge was chargeable with notice of the contents of these patents (*Boyden* v. *Burke*, 14 How. 575), yet he stood silent while rights were conferred upon others by their issue.

Also he distributed publicly to Members of Congress and others interested in such matters, and circulated in foreign nations, a pamphlet entitled "A Plan for Increasing the Efficiency of Cannon by Giving the Rifle Motion to Cannon Projectiles," which contained the drawings and a full description of his invention as disclosed in the patent application. (Tr. p. 21, Finding XIII.) This pamphlet did not disclose that a patent for the device was pending or that Woodbridge was the inventor of the device.

In view of the intervening rights of the various patentees of projectiles between 1852 and 1861, and the conduct of Woodbridge, the opinion of this Court in *Kendall* v. *Winsor*, 21 How. 322, 328, 329, is enlightening:

> It is undeniably true that the limited and temporary monopoly granted to inventors

> was never designed for their exclusive profit or advantage; the benefit to the public or community at large was another and doubtless the primary object in granting and securing that monopoly. * * * The rights and interests, whether of the public or of individuals, *can never be made to yield to schemes of selfishness or cupidity;* moreover, that which is once given to or is invested in the public can not be recalled nor taken from them. * * * It is the unquestionable right of every inventor to confer gratuitously the benefits of his ingenuity upon the public, and this he may do either by express declaration or by conduct equally significant with language—such, for instance, as an acquiescence with full knowledge in the use of his invention by others; or he may forfeit his rights as an inventor by a *willful or negligent postponement of his claims, or by an attempt to withhold the benefit of his improvement from the public until a similar or the same improvement should have been made and introduced by others.* Whilst the remuneration of genius and useful ingenuity is a duty incumbent upon the public, the rights and welfare of the community must be fairly dealt with and effectually guarded. *Considerations of individual emolument can never be permitted to operate to the injury of these.* (Italics ours.)

In *Consolidated Fruit Jar Co.* v. *Wright,* 12 Blach. 149, though the facts are not identical with the present case, the following quotation clearly lays down the rule governing Woodbridge's case, page 156:

> If an inventor without substantial reason or excuse abandons the use of his invention and for nine years sleeps on his rights, and in the meantime others in good faith employ their industry, skill, and money in producing the same thing, and give the public the benefit thereof, putting it into extensive use and on sale, such a state of facts not only warrants the inference of abandonment by the first inventor, but it also creates, as between him and the others, the same equity as would arise if such others had gone further and taken out a patent. Whether the device be patented, or has "gone into use without a patent," should make no difference. (*Kendall* v. *Winsor*, 21 How. 322.) This is not because lapse of time, *per se*, deprives an inventor of his right, but because the circumstances giving character to the delay indicate abandonment; and *also because the intervening rights of others make it inequitable that he should thereafter be permitted to assert any such exclusive title to the invention.* (Italics ours.)

Passing for a moment the fact that Woodbridge never yet received a patent for his invention, even patentees may forfeit their rights by conduct.

In *Wyeth* v. *Stone*, 1 Story, 273, 281–282, the Court said:

> In the next place, as to Wyeth's supposed abandonment of his invention to the public, since he obtained his patent, I agree that it is quite competent for a patentee at any time, by overt acts or by express dedication, to abandon or surrender to the public, for their

use, all the rights secured by his patent, if such is his pleasure, clearly and deliberately expressed. So, if for a series of years the patentee acquiesces without objection in the known public use by others of his invention, or stands by and encourages such use, such conduct will afford a very strong presumption of such an actual abandonment or surrender. *A fortiori*, the doctrine will apply to a case where the patentee has *openly encouraged* or silently acquiesced in such use by the very defendants whom he afterwards seeks to prohibit by injunction from any further use; for, in this way, he may not only *mislead them into expenses*, or acts, or contracts, against which they might otherwise have guarded themselves; but *his conduct operates as a surprise, if not as a fraud, upon them.* At all events, if such a defense were not a complete defense at law in a suit for any infringement of the patent, it would certainly furnish a clear and satisfactory ground why a court of equity should not interfere either to grant an injunction, or to protect the patentee, or to give any other relief. This doctrine is fully recognized in *Rundell* v. *Murray* (Jacob's R. 311, 316), and *Saunders* v. *Smith* (3 Mylne & Craig, 711, 728, 730, 735). But if there were no authority on the point, I should not have the slightest difficulty in asserting the doctrine, as found in the very nature and character of the jurisdiction, exercised by courts of equity on this and other analogous subjects.

The facts surrounding Woodbridge's application for patent, the unique attempt made to abandon all

activity looking toward issuance of a patent by the *secret filing*, and at the same time keep in active being all rights incident to a proper course, render the case isolated as to exact precedent, but that this fact should obscure the application of general principles is unthinkable. No excuse can possibly avoid the fact that Woodbridge adopted his procedure without regard to law and solely for his own personal enrichment, and that he forfeited through laches and abandonment rights that, by a simple request to issue in 1852, would have resulted speedily in a patent.

Appellant is in error in his contention that intervening rights may only be based on actual intervening manufacture and public use. In the analogous cases of reissue, involving the doctrine of abandonment or dedication to the public by the issue of a patent of everything which the inventor does not claim as his monopoly, the issue of patents to others while the inventor delays his application for reissue, will create intervening rights in favor of the public with equal force.

In *Clements* v. *Odorless Apparatus Co.*, this Court speaking by Mr. Justice Blatchford, said, after referring to the granting of two patents to inventors other than the patentee in the interval between the grant of the original patent and the application for reissue thereof in suit:

> The foregoing state of facts brings this case within the principles laid down in *Miller* v. *Brass Co.*, 104 U. S. 350; and *James* v. *Camp-*

bell, 104 U. S. 356. * * * The expansions in claims 1 and 3 of the reissue were afterthoughts, developed by the subsequent course of improvement in the Scharf and Frazier patents, and intended to cover matters appearing in those patents and not claimed in the original patent No. 115565. No excuse is given for the delay in applying for the reissue, nor is any actual inadvertence, accident, or mistake shown. The omission to claim subcombinations in the combinations claimed, the existence of such subcombinations being apparent on the face of the original patent, was, in law, on the facts in this case, such a dedication of them, if new, to the public, that a reissue, to cover such subcombinations, in revocation of such dedication, can not be availed of to the prejudice of rights acquired by the public to what is shown in the Scharf and Frazier patents, issued before the reissue was applied for. *Clements* v. *Odorless Excavating Apparatus Co.*, 109 U. S. 641, 649.

In the present case, while Woodbridge's application was lying in the secret archives for over nine years, he published and widely circulated a pamphlet fully describing it (Finding VIII, Tr. 20), but not disclosing "the fact that a patent for said device had been applied for, or who was the inventor of the device." During this period fourteen patents (Tr. 21, 22) were "added to the art." Among these were Hotchkiss, No. 13679, granted October 16, 1855; Sawyer, No. 13799, granted November 13, 1855; Hotchkiss, No. 29272, granted July 24, 1860; Hotch-

kiss, No. 32293, granted May 14, 1861; Dahlgren, No. 32986, granted August 6, 1861; Parrott, No. 33099, granted August 20, 1861; and Parrott, No. 33100, granted August 20, 1861.

These are the very patents the use of which by the defendant is complained of. They are recited, among others, in appellant's petition (Tr. 6); they are identified by the Court below with the devices used by the defendant during the period in suit (see Finding XII, Tr. 23, and Exhibits 1 to 12, following page 24 of the Transcript); and there is very little showing of use by the defendant of any other devices.

The total weight of the projectiles shown in Finding XII is 70,102,905 pounds. Omitting the Dahlgren projectiles, whose quantity the Court could not determine, there are of the Hotchkiss, Parrott, and Sawyer projectiles alone 61,705,962 pounds, or over 88 per cent of the total. On the basis of royalty found by the Court (Finding XII, Tr. 23) to be reasonable, the total amount is $455,668.88, of which some $401,000 would be paid for the use by the defendant of devices patented during the period while Woodbridge's application was lying inactive.

And this use had apparently begun before Woodbridge asked on December 31, 1861, that his long-secret application be granted. In the petition (Tr. 6) the use is alleged in general terms to have been "During the periods from March 25, 1852, to March 25, 1869"; the Court finds (Finding XII, Tr. 23) it

took place "During the period of time from the year 1861 to March 25, 1869"; Woodbridge's letter of December 31, 1861 (Tr. 14), he says it is "only lately that any immediate opportunity of rendering it pecuniarily available has occurred." It is not found as a fact, but intimated in the opinion (Tr. 28) of the Court below, that Woodbridge was stirred into activity by the fact coming to his knowledge that the defendants were at that time actually using the Hotchkiss patent.

Taking it all through, the long failure to perfect his claim, the equally long publication of the invention by pamphlet without claim, the grant of patents in the meantime, the use of which by the defendant is in large part the very foundation of this suit, a use beginning before December 31, 1861, and apparently known to Woodbridge before that time, the principle underlying the decision of this Court in *Clements* v. *Odorless Excavating Apparatus Co.* (*supra*), seems to directly apply.

Indeed, in *Mahn* v. *Harwood*, 112 U. S. 354, 363, this Court held that the subject matter attempted to be covered by a reissue had been dedicated to the public where there had been a delay of nearly four years without any excuse for the delay, without any showing or suggestion in the opinion (or in the record, see *Ex parte Hoiland*, 285 O. G. 391) that any intervening rights had occurred, either by the grant of patents to other parties or by the invention having come into use or otherwise, except by the

long possession by the public of the original patent without the reissued claims. While no doubt the principles in regard to reissue applications laid down in *Miller* v. *The Brass Company*, 104 U. S. 350, and numerous other cases, will not in all respects apply to all cases of alleged dedication or abandonment, there seems little to distinguish them from the present case, wherein the publication by Woodbridge in 1852 of the full description of his invention without any statement of claim to it, was accompanied by a delay of over nine years in making any attempt to render effective his claim founded on his original and secret application.

The *Berliner* and *Selden cases* cited by appellant have no relation to this case. Congress has now fixed short terms for successive actions, and these cases merely hold that constructive abandonment can not follow where the applicant acts within the periods now definitely set by law.

WOODBRIDGE FORFEITED OR ABANDONED HIS RIGHT TO A PATENT BY HIS ACQUIESCENCE FOR NINE YEARS IN THE ADVERSE DECISION OF THE BOARD OF EXAMINERS IN CHIEF RENDERED JULY 10, 1862, AND BY EIGHT YEARS' ADDITIONAL DELAY AFTER FILING HIS APPEAL IN 1871.

After the original delay of nine years Woodbridge wrote to the Commissioner of Patents on December 31, 1861, asking for the issuance of his patent. The request was denied and this denial was, on appeal, affirmed by the Board of Examiners in Chief July 10, 1862, Woodbridge receiving notice in a letter

from the Patent Office dated July 15, 1862 (Tr. p. 16, Finding V). He thereupon had the right of appeal to the Commissioner in person under section 27 of the Act of 1861. Instead of appealing he acquiesced in this adverse decision until January 7, 1871, a period of more than nine years, during which time the Civil War had been fought and the further development of the projectile art was stimulated. He gave no reason whatever for this period of delay. The Court of Claims has found (Tr. p. 22, Finding XI) that during this period of acquiescence twenty-two United States patents in the projectile art were issued. This development of the art was made not through the efforts of Woodbridge but during a time when he was still, so far as the public and inventors at large were concerned, hidden in the Patent Office without any notice or suggestion of Woodbridge's applications or claims.

In the case of *United States Rifle & Cartridge Co.* v. *Whitney Arms Co.*, 118 U. S. 22, 25, the court, speaking of an inventor acquiescing in the adverse decision of a Patent Office tribunal, said:

> An inventor whose application for a patent has been rejected, and who, without substantial reason and excuse, omits for many years to take any step to reinstate or renew it, must be held to have acquiesced in its rejection, and to have abandoned any intention of further prosecuting his claim.

In *Planing Machine Co.* v. *Keith*, 101 U. S. 479, 485, a case having a similar state of facts to the

present one and dealing with the same period of the Patent Law, the court said:

> An inventor *can not, without cause,* hold his application pending during a long period of years, leaving the public uncertain whether he intends ever to prosecute it, and keeping the field of his invention closed against other inventors. It is not unfair to him, after his application for a patent has been rejected, and after he has for many years taken no steps to reinstate it, to renew it, or to appeal, that it should be concluded he has acquiesced in the rejection and abandoned any intention of prosecuting his claim further. Such a conclusion is in accordance with common observation. Especially is this so when, during those years of his inaction, he saw his invention go into common use and neither uttered a word of complaint or remonstrance, nor was stimulated by it to a fresh attempt to obtain a patent. When in reliance upon his supine inaction the public has made use of the result of his ingenuity, and has accommodated its business and its machinery to the improvement, it is not unjust to him to hold that he shall be regarded as having assented to the appropriation, or, in other words, as having abandoned the invention.

Woodbridge waited until January 7, 1871, the last day of his six months' period mentioned in section 35 of the Act of 1870 upon which he relied, before filing his appeal. That his reliance upon it was unfounded is shown in the contemporaneous cases of *Whitney* and *Keith* just considered.

In *Marsh* v. *Commissioner of Patents* (3 Bissell, 322) the applicant Marsh averred that he had never in fact abandoned his invention. The court said:

> We think the simple allegation that he did not abandon his claim to the public is not enough to rebut the presumption arising from this state of facts. It is not necessary to decide whether any satisfactory explanation could be given of so long a delay. It is not furnished in this bill. It is plain that in consequence of the decision in the case of *Sayles* v. *Hapgood* an attempt was afterwards made to recall an abandoned claim. To sustain this bill would be to vitalize many an old, forgotten claim that now lies buried under the rubbish of the Patent Office. We think it is no answer to say that for his invention Marsh ought to have had a patent; because the meaning of that is he ought to have had it, if he, within a reasonable time, and by the methods the law points out, had sought to obtain it.
>
> The 35th section of the patent law of 1870 declares that any person who has an interest in an invention where a patent was order of issue on the payment of the final fee, and who has failed to make payment within six months from the time when it was allowed * * * shall have a right to make an application for a patent the same as in an original application: "*Provided,* That the second application be made within two years after the allowance of the original application." * * * "*And provided further,* That when an application for a patent has been rejected or withdrawn prior to the passage of this act the applicant shall

have six months from the date of such passage to renew his application or to file a new one, and if he omit to do either his application shall be held to have been abandoned."

It is argued that the plaintiff is within the terms of this section, and that the second proviso applies literally to the facts of this case. It is true that the application of the plaintiff for a patent was rejected prior to the passage of the act, and it is insisted that the sequence to this is that the applicant has six months from the date of its passage to renew his application. This is in fact the letter of the proviso, and yet it must be true that it is subject to the implied condition that the applicant has not lost his right to make the application by abandonment or surrender of the same. It could not have been intended to restore what had already been voluntarily given to the public, or what had become the property of the public, by the neglect or refusal for a series of years to prosecute what was originally a valid claim. Here the neglect or refusal had continued for more than eighteen years, and we can not think that the proviso in the 35th section was intended to include a claim so stale as this. It may be admitted that, as stated in the last clause of the 35th section, abandonment is a question of fact, and we hold, notwithstanding the denial and pretexts to the contrary stated, that Marsh did in fact abandon his claim to the public; that such is the necessary conclusion from the allegations contained in the bill.

But Woodbridge's negligence did not end with his appeal to the Commissioner in 1871. Hearing on this appeal was set for February 14, 1871, and notice thereof was mailed to Woodbridge at Perth Amboy, New Jersey, his former address, but did not reach him. A few weeks later, learning of this fact, he advised the Commissioner that the notice had not reached him. Thereupon another date for hearing was set, which was later found impracticable by the Commissioner, who promised Woodbridge that he would give him another date for hearing. No further action was taken in the matter by either the Patent Office or Woodbridge until January, 1879, when the Patent Office, in response to a request by Woodbridge, notified him that the hearing was set for January 23, 1879. On February 13, 1879, the Commissioner affirmed the decision of the Board of Examiners in Chief refusing Woodbridge's patent upon the ground of abandonment. No reason appears in the findings of fact for the unreasonable delay of Woodbridge between the notice from the Commissioner reaching him in 1871 and the hearing in 1879 save the few weeks intervening between his actual notice and the time of mailing the notice with a faulty address and the inpracticability of the date of the first hearing set by the Commissioner thereafter. It is submitted that this period alone of acquiescence in and of failure to energetically prosecute his appeal from the unfavorable decision of the Board of Examiners in Chief, unexplained as it is, is enough in itself

upon which to predicate abandonment. On April 9, 1879, Woodbridge appealed from the Commissioner's decision to the Supreme Court of the District of Columbia, which court affirmed the Commissioner's decision February 28, 1880, apparently without dissent.

There was a further remedy available to Woodbridge, which was a proceeding under Section 4915 of the Revised Statutes, a bill in equity to compel the issuance of a patent, but he never took advantage of it. Thus we have a period from 1852 to 1879 that Woodbridge allowed his application to drag along in the Patent Office, the public receiving no notice of its presence there, no reason to believe that the field was not open and, as the findings show, active in the same field.

The decisions of the several tribunals which passed upon the merits of Woodbridge's claim are not made a part of the findings of fact of the court, yet the application, drawings, and history of the communications passing between the Patent Office and Woodbridge are a part of the findings and of course constituted the record of facts in all of the tribunals that had unanimously considered and held that Woodbridge had abandoned his rights.

The Court of Claims, in Finding XII, has set forth the number of pounds of projectiles manufactured under patents issued while the Woodbridge invention lay secret, so far as the public was concerned, in the Patent Office. A very significant infer-

ence is drawn because of the comparatively few patents issued for projectiles of the Woodbridge type prior to his letter of December 31, 1861, to the Commissioner asking for the issuance of his patent and the showing made from that date on until 1869. Unquestionably Woodbridge wrote truthfully in his letter of December 31, 1861, wherein he said (Tr. p. 14, Finding III):

> I have allowed it to remain until the present time, it being only lately that any immediate opportunity of rendering it pecuniarily available has occurred.

In view of the above discussion, it is probably unnecessary to consider further the delay that took place between the filing of the appeal on January 7, 1871, and the final hearing of the appeal, eight years after, in February, 1879. The Commissioner may have felt himself justified in paying little attention during this long period to an applicant who was so little insistent on his rights.

During the rolling of the years from March, 1852, to February, 1879, Commissioners of Patents came and went—fifteen of them. Surely there must have been one out of these fifteen men who would have been willing to give the applicant fair treatment, if he had asked for it. During the period from March, 1852, to December 31, 1861, when his application was lying ungranted under the notice from the Commissioner (Tr. 13) that it was "subject to your (Woodbridge's) directions as to the time of issuing the same," seven different Commissioners followed

one after the other. During the period of his delay in entering his appeal to the Commissioner from the adverse decision of the Board, four more Commissioners followed. And during the period when he waited for hearing on his appeal, four more.

> The court will take notice judicially of the persons who from time to time preside over the Patent Office, whether permanently or transiently. *N. Y. & Maryland Line R. R. Co.* v. *Winans*, 17 How. 30, 40.

It is not contended that, in the absence of a statutory bar, setting fixed limits for failing to act during which abandonment will be conclusively presumed, mere delay in itself results in abandonment, but that long delay, not caused by circumstances over which the applicant had no control, such as protracted sickness, extreme poverty, residence during a state of war within the enemy's lines, time necessary to complete the invention, etc., all of which appear in the books and the first two of which are characterized by this Court in the *Planing Machine case* as "these ordinary and accepted reasons for inaction," but caused intentionally, with the invention as complete then as it is now, a delay deliberate and merely for the purpose of postponing the beginning of the monopoly, while numerous other inventions had been patented and the public had become entitled to their benefits, and while for years the very manufacture complained of had been going on to the full knowledge of the

inventor, presents such an overwhelming presumption of intention to abandon and of the inequity of the revival of appellant's claim as we fail to find justified by the action of any court.

THE GOVERNMENT DID NOT INFRINGE THE INVENTION OF WOODBRIDGE.

The question of infringement by the United States of claim 1 of the allowed Woodbridge application is a live question only if the Court of Claims should first "be satisfied that the said Woodbridge did not forfeit or abandon his right to a patent by publication, delay, laches, or otherwise; and that the said patent was wrongfully refused to be issued by the Patent Office."

As previously pointed out, when the Court of Claims dismissed the petition, that action was in effect a determination that Woodbridge had forfeited all rights in his invention, and that the Patent Office had not wrongfully refused to issue to him a patent. That being the result of the Court of Claims' action, a discussion of the question of infringement was perhaps gratuitous by the Court and need not be considered here on appeal. So long, however, as Judge Booth considers the question and a finding is based upon that matter (Tr. p. 23, Finding XIV) it will be briefly discussed.

THE REAL WOODBRIDGE INVENTION.

There is no foundation for the extravagant claim for the Woodbridge invention found at the bottom of

page 16 of appellants' brief. If Woodbridge did these things he did not mention it in his specification and his invention was in no way concerned in the development of the art.

The simple fact is that he was misled in applying small-arms practice to ordnance by the mistakes of previous inventors. He says it has been shown that lead rings would not do for heavy shells (Tr. 12), and he evidently had learned of Manton's success (Tr. p. 19) in experiments with a wooden cup having projections fitting the rifle grooves. These two errors of judgment led him to complete failure.

The Woodbridge invention, stripped of all surplusage usually present in a patent specification, consisted of a hard-metal projectile provided with a soft-metal sabot in the shape of a circular wedge embracing the projectile in the rear of its greatest diameter, the exterior of the sabot having the form of the bore of the gun in which it was to be fired—that is, with projections entering and fitting the grooves of the bore. The sabot was provided with an annular groove at its rear, forming two concentric circular valvular lips to be expanded by the explosive force of the powder against the bore of the gun and the projectile respectively. The valvular lips under the force of the explosive sealed the sabot against the slight space between it and the bore of the gun and prevented windage, windage being a term applied in ballistics to a leakage of the gases of the powder under combustion past the projectile and so disturbing the

true progress of the projectile through the bore of the gun. The applicant, Woodbridge (p. 10, Tr.), states:

> The nature of my invention consists in applying to a projectile to be fired from a rifled gun a rifle-ring, or sabot, in the manner hereinafter described, for the purpose of giving to the projectile the rifle motion.

Again (Tr. p. 10), in describing the operation of his invention (lines 34–42)—

> The surface of the rifle ring exposed to the action of the gases formed by the inflammation of the powder being much greater, in proportion to its inertia, than that of the ball, the ring is driven forcibly forward upon the ball so as to embrace it tightly, and thus impart the rifle motion which itself has received from the grooves of the gun; and at the same time it is stretched to fill the bore of the gun completely, thus destroying the windage and causing the ball to advance strictly in the line of the axis of the bore.

After a rejection by the Patent Office, February 16, 1852, Woodbridge on February 23, 1852, replied by an argument seeking to obviate certain references cited by the Patent Office. Speaking of the sabot (Tr. 12, lines 7–29), it is stated:

> 1st. It is necessarily a ring capable of extension without rupture.
>
> 2nd. It grasps the ball, not in consequence of being attached thereto before its insertion into the gun, but by being driven forcibly

forward upon an enlarged part of the projectile, by the explosion of the powder within the gun, the practical value of which arrangement is that the ring fully retains its grasp on the ball, though the ball does not fully take the rifle motion at the first instant of its progression. Experiments have fully shown that leaden bands can not be made to give the rifle motion to balls of any considerable weight, however strongly attached.

3d. As a necessary result of the stretching of the ring, as above spoken of, it is expanded so as completely to fill the bore of the gun, giving greater accuracy to the coincidence of the motion of the ball with the axis of the bore than would otherwise be obtained.

4th. The valvular portions are important parts of the rifle ring. If the gases are allowed to enter the space between the ring and the ball, the ring is not pressed against the ball so as to grasp it as required, or stretch it against the sides of the bore; if the gases escape between the rifle ring and the sides of the bore, the ring is rapidly abraded by the current of heated gases.

None of these characteristics are indicated, as I am aware, in the article referred to, *and it was my intention to claim nothing else in my specification.*

Upon receipt of this argument and definition of his invention, the Patent Office on March 19, 1852, wrote Woodbridge, suggesting the form of two claims which would be acceptable and allowed; the inventor accepted the claims and they were allowed. (Tr.

p. 13.) By this specific definition of Woodbridge as to his invention he has placed a construction upon it, and the acceptance by the Patent Office of such a construction and the consequent allowance of the suggested claims is a binding limitation upon the inventor forever. Again, after fully describing and indicating by reference to drawings found between pages 10 and 11 of the record, which illustrate a form of sabot with projections and designed to be used only in rifle cannon, the inventor states (Tr. p. 10, last line, and p. 11, lines 1–4):

> I also propose to use a similar ring or sabot (but without the projections for the grooves of the gun) for spherical or other shot in smooth-bore guns, for avoiding the loss of force by windage, and for giving the ball its motion in the direction of the axis of the bore of the gun.

Now, taking all the statements heretofore referred to by the inventor, the specification, claims, and drawings, it is clear that Woodbridge, in order to give the *rifle motion* to a projectile fitted with his sabot, contemplated the use of a sabot with projections which fitted into the grooves of a rifled cannon. No suggestion anywhere appears of a thought that the sabot metal will flow under pressure into the rifle grooves.

He sets forth in his specification (p. 10, line 24) that his invention relates to a sabot "whose exterior surface has the form of the bore, but sufficiently smaller to allow it to be readily introduced into the

gun." To have the form of the bore of a rifle cannon about which the inventor is speaking, the sabot would have to be provided with extensions or projections as indicated at Figure 5, drawing 18, illustrated in the record. The use of sabots in rifled cannon was not the only use the inventor contemplated for his sabot, for when he desired to utilize his sabot in a smoothbore cannon he provided no projections on the sabot, because they would not be needed to prevent windage or for giving the ball or projectile its motion in the direction of the axis of the bore of the gun. (Tr. p. 10, last line; p. 11, lines 1–4.) Nothing can be more apparent in view of the disclosures in his specification that Woodbridge had no thought in 1852 of using a smooth sabot in rifled cannon. This fact is emphasized with great force by his letter of December 31, 1864 (Tr. 14, Finding III), wherein, speaking of the specification as it stood on allowance by the Patent Office in 1852, he says:

> The specification as it is makes no special invention, I believe, of using the ring described without projections in a rifled gun * * *.

Woodbridge here declares in his letter to the Patent Office that the very construction now urged upon the court—that is to say, the use of a smooth sabot in a rifled cannon—was not present in his specification as allowed in 1852, and seeks by an amendment to make "special invention" by the addition of the words "Whether the hinder part of the ring be grooved or not, and without regard to

the form of the bore." (Tr. p. 14, Finding III, lines 36–37.) This and other attempts in this letter to completely wipe out and nullify the self-imposed limitations present in his specification and claims allowed in 1852 comes over nine years later and the conclusion must be that Woodbridge's experience and knowledge of the projectile art during the intervening period led him to suggest this change as well as an admission that change was necessary. He had never prior to that time in any portion of his specification or claims in any way suggested the use of a projectile having a rifle motion imparted to it by the use of a smooth sabot in a smooth bore cannon, for, as he rightfully remarks, the purpose of such sabots in smooth bore cannon was that of "avoiding the loss of force by windage and for giving the ball its motion in the direction of the axis of the bore of the gun." (Tr. p. 13, lines 30–32.)

There is no foundation for the present attempt to show that the projections were made to take into the grooves by the expansion of the ring. Woodbridge was working with muzzle loaders. The ring had to be pushed in from the front and unless the projections were in the grooves always, they were never in. Mordecai's precautions (Tr. 18) in loading show how close the fit was.

THE ALLEGED INFRINGEMENT—DEFENDANT'S STRUCTURES.

We will dismiss in few words the assertion of claim by appellants to compensation for defendant's

shells when used in smoothbore guns. The Act (Tr. 1) referred only to "the claim of William E. Woodbridge for compensation for the use of his alleged invention relating to projectiles for rifled cannon;" the findings of the Court below (Finding XII, Tr. 23) show only the use by defendant of the devices complained of "in *rifled* cannon;" there is no finding whatever that they were ever used in *smoothbore* guns, and all assertions of appellants and references to the evidence and admissions of defendant are founded on matters not before this Court.

For the purpose of review by the Supreme Court, the findings of the Court of Claims "are to be treated like the verdict of a jury" and the Supreme Court is "not at liberty to refer to the evidence, any more than to the opinion, for the purpose of eking out, controlling, or modifying their scope." (*Brothers* v. *United States*, 250 U. S. 88, 93.)

The Government's liability is to be measured by the infringement or use of certain designated types of projectile which the Court of Claims has illustrated in appendix to Finding of Fact XII and designated Exhibits 1 to 12, inclusive. (Tr. between pp. 24 and 25.)

In none of these various types of projectile is there found one which employs a sabot having extensions registering with the grooves in a rifled gun or cannon for the purpose of giving a rifled motion to the projectile. In none is there a sabot which is not so firmly attached to the projectile as to impart to the

projectile at the moment of the explosion of the powder, the rifled motion and not as described by Woodbridge (Tr. p. 12):

> It grasps the ball, not in consequence of being attached thereto before its insertion into the gun, but by being driven forcibly forward upon an enlarged part of the projectile by the explosive of the powder within the gun, the practical value of which arrangement is that the ring fully retains its grasp on the ball, though the ball does not fully take the rifle motion at the first instant of its progression.
>
> Experiments have shown that leaden bands can not be made to give the rifle motion to balls of any considerable weight however strongly attached.

The claimant takes a very different view of his invention when endeavoring to get his patent or distinguishing it from the prior art, from that taken when he considers it with relation to defendant's structures. In the first attitude he points out the entire disconnection of the rifle ring from the shell; in the second he claims that even the Arrick structure, wherein the projectile is entirely and immovably embedded in the soft metal cover, infringes. In the first attitude he insists upon the use of a metal ring capable of extension without rupture; in the second he holds that devices, the metal of which is ruptured and caused to flow under pressure, a thought he never suggested, are infringements.

THE FAILURE OF THE WOODBRIDGE INVENTION.

There must have been some reason for the failure of the Woodbridge invention while so many others succeeded. The reasons sufficiently appear in the reports of the Army officers who tested it in 1850 (Tr. pp. 17–20), which need no elaboration here. We believe that in 1850 only three rounds were ever fired of this invention when trouble developed. Since then it has never been used.

It is submitted that in view of the prior inventions cited against the application of Woodbridge in 1852 his subsequent limitation of his invention as before shown, the prior art listed on page 21 of the transcript, and the finding of the Court as to what the United States used, no infringement of the invention of Woodbridge can be possibly found.

The judgment of the Court of Claims should be affirmed.

Respectfully submitted.

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